

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 38

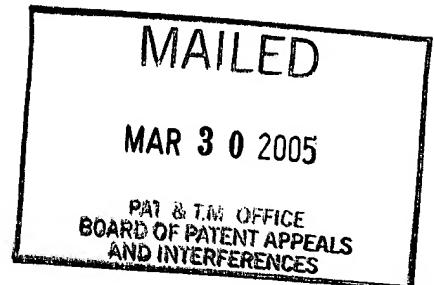
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

**Ex parte** ROBERT H. SHELTON

Appeal No. 2004-2051  
Application 09/025,279

HEARD: MARCH 10, 2005



Before RUGGIERO, DIXON, and MACDONALD, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 1-81.

**Invention**

Appellant's invention relates to a system and method for medical database access control. The system and method provides for authentication of the identity of a data requesting party in a database search of patient records. The system and method also provides a patient about whom the records pertain an express opportunity to either approve or decline whether such records may be transferred on a case-by-case basis as database search requests are received. Appellant's specification at page 11, lines 17-23.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A medical data base supervisory control system comprising:

(a) at least one data base including medical data individually relating to each of a plurality of patients,

(b) means including interconnected computers for requesting and accessing said medical data,

(c) means for identifying medical data for each of said patients with conditions required for accessing said medical data, and

(d) data processing means responsive to a request for patient medical data for comparing said request with said conditions required for access to said data and, when said request fails to comply with said conditions, for denying access to said data.

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#### **References**

The references relied on by the Examiner are as follows:

Evans	5,924,074	Jul. 13, 1999
Anderson; A Security Policy Model for Clinical Information Systems; February 1996.		

#### **Rejections At Issue**

Claims 1-2, 4-43, and 45-81 stand rejected under 35 U.S.C. § 103 as being obvious over Evans.

Claims 3 and 44 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Evans and Anderson.

Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.<sup>1</sup>

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<sup>1</sup>Appellant filed a supplemental appeal brief ("the brief" herein-after) on December 10, 2001, replacing an appeal brief filed June 8, 2001. Appellant filed a reply brief on March 31, 2003. The Examiner mailed an Examiner's Answer on January 28, 2003.

**OPINION**

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated **infra**, we reverse the Examiner's rejection of claims 1-81 under 35 U.S.C. § 103.

Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellant [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Appellant has indicated that for purposes of this appeal the claims do not stand or fall together and are separately patentable. See page 8 of the brief. However, Appellant fails to argue each of the claims separately and fails to explain why the claims are believed to be separately patentable. See pages 15-52 of the brief and pages 1-38 of the reply brief. With respect to claims 2, 4-41, 43, and 45-81, Appellant merely points out differences in what the claims cover at pages 8-15 of the brief. Therefore, Appellant has not presented arguments as to why these claims are separately patentable. 37 CFR § 1.192

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(c) (7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellant's filing of the brief, states:

*Grouping of claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. **Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.** (Emphasis added)

Further, Appellant argues claim 42 together with claim 1, and argues claim 3 together with claim 44. For these reasons we will, thereby, consider Appellant's claims as standing or falling together in two groups corresponding to the rejections noted above, and we will treat:

Claim 1 as a representative claim of Group I; and

Claim 3 as a representative claim of Group II.

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim. **In re McDaniel**, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465

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(Fed. Cir. 2002). **See also In re Watts**, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

**I. Whether the Rejection of Claims 1-2, 4-43, and 45-81  
Under 35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 1-2, 4-43, and 45-81. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, we find the detailed arguments presented by Appellant to be unpersuasive. However, we agree with Appellant's broad argument that the Examiner has not shown that claim 1 is obvious over the Evans patent. Appellant's claim 1 requires "means for identifying medical data for each of said patients with conditions required for accessing said medical data." We agree fully with the Examiner that the patient's identifier meets the requirements recited in claim 1 for a condition. However, claim 1 requires plural "conditions" for each patient and Evans only teaches a single condition. Further, the Examiner has not pointed out why it would have been obvious to add a second access condition identified with the medical data

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of a patient to the Evans system. For this reason alone, we find the Examiner has not met the initial burden of establishing a **prima facie** case of obviousness. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

We address Appellant's major arguments below. We note that some of Appellant's arguments fail to indicate the claim or claims to which Appellant is addressing the argument. In such cases this Board does not choose to substitute its best guess as to which claim(s) are being addressed. Appellant should always indicate the claim(s) that an argument addresses.

With respect to the definition of the term "condition", Appellant argues this term should be interpreted as being limited to the disclosed "prior authorization by the patient." We do not find this argument persuasive as Appellant has specifically stated at the last paragraph of the specification that the claimed invention is not to be so limited. On its face, entry of the correct patient identifier is a condition to accessing the patient's medical data.

Appellant also argues that "not granting access when a system is unable to process a request" and "denying access when a request does not complied with conditions" have nothing to do

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with each other. We find this unpersuasive. We agree with the Examiner that there is no difference between the two.

Appellant presents a lengthy argument at pages 27-34 of the brief directed to a second Anderson reference. That reference is not part of the record before us, and Appellant's arguments directed thereto are not relevant to the issues before this Board.

Appellant argues that combining the Evans and Anderson references is base on impermissible hindsight. We disagree. Both references are concerned with the security of patient data and both references place at least one condition on access of that data. Clearly both references are directed to solving the same problem.

Appellant argues at pages 44-45 of the brief that, "Appellant's claimed invention meets an important need long felt in the art." We find Appellant's argument unpersuasive. First, we do not find in the record before us an affidavit or declaration under 37 CFR § 1.132. Second, Appellant's argument at pages 44-46 fails to discuss any of the long felt need factors discussed at MPEP § 716.04.

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**II. Whether the Rejection of Claims 3 and 44 Under  
35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 3 and 44. Accordingly, we reverse.

With respect to dependent claims 3 and 44, we note that the Examiner has relied on the Anderson reference solely to teach preventing access without prior authorization of the patient about whom the record pertains. The Anderson reference in combination with the Evans reference fails to cure the deficiencies of Evans noted above with respect to claim 1. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

**Other Issues**

Before further prosecution of the present application, we recommend that the Examiner review the patents (U.S. Patents 5917912, 5949876, and 5982891) assigned to InterTrust Technologies Corporation that address electronic rights protection.

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**Conclusion**

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 103 of claims 1-81.

**REVERSED**



JOSEPH F. RUGGIERO )  
Administrative Patent Judge )



JOSEPH L. DIXON )  
Administrative Patent Judge )

BOARD OF PATENT  
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ALLEN R. MACDONALD )  
Administrative Patent Judge )

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